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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,211

11/18/2003

Barry Appelman

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EXAMINER

WALSH, JOHN B

ART UNIT

PAPER NUMBER

2451

NOTIFICATION DATE

DELIVERY MODE

06/24/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/715,211	Applicant(s) APPELMAN ET AL.	
	Examiner John B. Walsh	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21, 38-44, 60-63, 65-69 and 71-98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-21, 38-44, 60-63, 65-69, 71-77 and 81-98 is/are rejected.
- 7) ☒ Claim(s) 78-80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/2/09; 6/8/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 2-21, 38-44, 60-63, 65-69, 71-76 and 82-98 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

The claims are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 4, 6-21, 38-44, 60-63, 65-69, 71-77, 81-85 and 87-98 are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,401,098 to Baker.

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As concerns claims 60, 77, 81 and 89 determining an online context of a user (col. 8, lines 46-48; col. 9, lines 15-20), the online context being one or more of a website currently accessed by the user, an Internet domain currently accessed by the user, a newsgroup currently accessed by the user, a message board currently accessed by the user (col. 8, lines 46-48), or a URL currently accessed by the user; determining an online context of the other users (col. 8, lines 46-48); storing trait information for the user (col. 3, line 63-col. 4, line 12); storing trait information for the other users (col. 3, line 63-col. 4, line 12); comparing the online context of the user to the online context of the other users and the stored trait information for the user to the stored trait information for the other users (fig. 3; col. 7, lines 2-12); based on the comparison, identifying a group of the other users sharing the online context (fig. 3) of the user and at least one trait with the user (fig. 3), the number of users in the group of the other users being less than the number of the other users (col. 4, lines 25-30); and causing presentation to the user of an indicator that identifies at least one user as a member of the group of the other users sharing the online context of the user and the at least one trait with the user (fig. 3; col. 4, lines 55-60-page and display logged in to chat).

As concerns claims 84 and 98, determining an online context of a first user (fig 3; col. 8, lines 46-48); determining an online context of a second user (fig 3; col. 8, lines 46-48); storing a buddy list for the first user (col. 3, lines 54-61- "friends" list); determining that the online context of the second user matches the online context of the first user (fig. 3) and that the second user is a member of the buddy list of the first user (fig. 3); and based on the determination that the online context of the second user matches the online context of the first user and that the second user is a member of the buddy list of the first user, causing presentation to the first user of an

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identifier that identifies the second user as having the same online context of the first user (fig. 3).

As concerns claims 4, 85 and 90, determining a message board currently accessed (col. 8, lines 46-48-chat room).

As concerns claim 6, determining where the user is presently focused (col. 8, lines 46-48-chat room by topic).

As concerns claim 7, identifying group of users sharing context and the at least one trait (fig. 3) and identifying users who enter and leave (fig. 3; col. 4, lines 55-60-page and display logged in to chat).

As concerns claims 8, 61 and 91, an age of the users (fig. 3; 124).

As concerns claims 9 and 62, a demographic (122).

As concerns claims 10, 68 and 82, an expertise rating (fig. 3, 120; fig. 2, IQ).

As concerns claims 11 and 66, an interest (fig. 2, party).

As concerns claims 12, 13 and 14, a participation status comprises a visibility preference (fig. 2, status).

As concerns claims 15 and 67, trait information of an associate (fig. 3, trait info of "friends/buddys").

As concerns claims 16 and 17, an online status (fig. 2, status) of active ("I'm available").

As concerns claim 18, storing other information (col. 12, lines 5-15).

As concerns claim 19, identification of a user (fig. 3, name, 118).

As concerns claim 20, online identifier (fig. 3, name, 118).

As concerns claim 21, contact information (online id can be used to contact user; also associated with an email address for notifications).

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As concerns claims 38, 39, 92 and 93, an instant message (chat).

As concerns claim 40, send an email (fig. 5, 262).

As concerns claim 41, a voice communication (col. 14, line 29; fig. 8).

As concerns claim 42, a mobile device (fig. 8).

As concerns claim 43, a contact list (fig. 2, 118; fig. 2, friends button under area 104).

As concerns claim 44, a buddy list (fig. 2, 118; fig. 2, friends button under area 104).

As concerns claims 63, 83 and 94, presentation to the user of the number of users (fig. 3).

As concerns claims 65 and 95, trait information (fig. 3).

As concerns claims 69, 87 and 96, presentation graphically (fig. 3).

As concerns claim 71, sorted by trait information (col. 11, lines 5-10-compatible based on trait info; col. 11, lines 25-35).

As concerns claims 72 and 73, a location (fig. 3; 126).

As concerns claims 74 and 75, repeating the method (col. 10, line 30-update info, therefore repeatable; col. 11, line 16).

As concerns claims 76 and 97, a changed online context (col. 10, line 30-update info; col. 11, line 16).

As concerns claim 88, a subgroup (grouped based on additional traits; col. 12, lines 10-15).

Allowable Subject Matter

5. The indicated allowability of claims is withdrawn in view of the newly discovered reference(s) to U.S. Patent No. 7,401,098 to Baker. A rejection based on the newly cited reference is cited above.

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6. Claims 2, 3, 5, 78-80 and 86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/
Primary Examiner, Art Unit 2451